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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SKED, MATTHEW J

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,395

Applicant(s)

SHERWOOD, AMY L.

Examiner

Matthew J Sked

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 5, 7-11, 13, 15, 17-19, 21, 22, 24, 30, 31, 33, 35-38, 40 and 41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Padmanabhan et al. (U.S. Pat. 6,219,638).

As per claims 1 and 18, Padmanabhan teaches a system for transcribing a recording message comprising:

a storing device for storing a recorded message (message stored on message server or telephony server, col. 3, lines 34-38);

a transcription device, in communication with the storing device, for transcribing a recorded message into a computer file (speech recognition server transcribes speech to text, col. 4, lines 15-17); and

an archival device, in communication with the transcription device, for reading the computer file and outputting or storing a transcribed version of the recorded message (text is stored or output, col. 4, lines 62-67).

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3. As per claim 8, Padmanabhan teaches a system for transcribing a recorded message comprising:

a voicemail message system for storing a recorded message (server accessed through a telephone to retrieve messages, col. 3, lines 22-24);

a transcription device operating a transcription software and in communication with the storing device, for transcribing a recorded message into a computer file (speech recognition server transcribes speech stored in telephony server, col. 4, lines 14-16); and

an archival device, in communication with the transcription device, for reading the computer file and outputting or storing a transcribed version of the recorded message (text is stored or output, col. 4, lines 62-67).

4. As per claim 10, Padmanabhan teaches a system for transcribing a recording message comprising:

a storing device for storing a recorded message (message stored on message server or telephony server, col. 3, lines 34-38);

a transcription device, in communication with the storing device, for transcribing a recorded message into a text file (speech recognition server transcribes speech to text, col. 4, lines 15-17);

a converting device for converting the text file to different formats that are recognized by different recording devices (sends the data via email, fax or page hence it must inherently have a converting device to change between these formats, col. 4, lines 62-67); and

a plurality of archival devices, each archival device in communication with the converting device and capable of reading a recognized format of the text file and outputting or storing a transcribed version of the recorded message (sends the data via email, fax or pager, col. 4, lines 62-67).

5. As per claim 30, Padmanabhan teaches a method of transcribing a recorded message comprising:

accessing a storing device storing a recorded message (message server accessed to retrieve messages, col. 3, lines 24-31);

listening to the recorded message (message server accessed by telephone so the user would inherently listen to the message, col. 3, lines 24-31);

indicating that the recorded message should be transcribed (gives the user the option if to transcribe the message or not, if the user chooses to transcribe the message it is recorded previously to transcription, col. 4, lines 1-4 and 10-15); and

designating an archival device to be used to output or store the transcribed message (user selects how to store or send the message, col. 4, lines 62-67).

6. As per claim 37, Padmanabhan teaches a method of transcribing a recorded message comprising:

accessing a voicemail system (messages saved on servers, hence implying voicemail, col. 3, lines 34-38);

listening to the recorded message (message server accessed by telephone so the user would inherently listen to the message, col. 3, lines 24-31);

indicating that the recorded message should be transcribed (gives the user the option if to transcribe the message or not, if the user chooses to transcribe the message it is recorded previously to transcription, col. 4, lines 1-4 and 10-15); and

designating a plurality of archival devices to be used to output or display the transcribed message (messages can be sent to multiple devices, col. 5, lines 21-33).

7. As per claims 2, 11, 19 and 31, Padmanabhan teaches the storing device is a voicemail message system (messages saved on servers, hence implying voicemail, col. 3, lines 34-38).

8. As per claims 4, 9, 13 and 21, Padmanabhan teaches the transcription device is an integral part of the storing device (elements of Fig. 1 can be implemented by one computer, the elements of Fig. 1 include both the speech recognition server and telephony server, col. 3, lines 15-18).

9. As per claims 5, 15, 22, 33 and 38, Padmanabhan teaches the archival device is an email (send text via email, col. 4, lines 62-67).

10. As per claims 7, 17, 24, 35 and 40, Padmanabhan teaches the archival device is a facsimile machine (send the text via fax, col. 4, lines 62-67).

11. As per claims 36 and 41, Padmanabhan teaches the archival device comprises a plurality of archival devices of different types (sends the data via email, fax or pager, col. 4, lines 62-67).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 6, 12, 16, 20, 23, 32, 34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padmanabhan.

As per claims 3, 12, 20, and 32, Padmanabhan does not teach the storing device is a telephone answering machine.

However, the Examiner takes Official Notice that the use of telephone answering machines is well known in transcription. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Padmanabhan to have the storage device be a telephone answering machine, the precursor of voicemail, because it would allow the system to operate for users still without voicemail, hence making it more marketable.

14. As per claims 6, 16, 23, 34, and 39, Padmanabhan does not teach the archival device to be a printer.

However, the Examiner takes Official Notice that printers are a well known output device in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Padmanabhan to have the archival device be a printer because it would give a hard copy transcription of the voice message hence facilitating use for the user.

15. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padmanabhan in view of Damiba et al. (U.S. Pat. Pub. 2002/0169605A1).

As per claim 25, Padmanabhan teaches a message transcription system for transcribing a recorded message comprising:

a storing device for storing a recorded message (message stored on message server or telephony server, col. 3, lines 34-38);

a transcription device, in communication with the storing device, for transcribing a recorded message (speech recognition server transcribes speech to text, col. 4, lines 15-17); and

a converting device for converting, in communication with the transcription device, for converting the transcribed message into a format that is readable by an archival device (sends the data via email, fax or page hence it must inherently have a converting device to change between these formats, col. 4, lines 62-67).

Padmanabhan does not teach the system being portable and having a port, in communication with the converting device and an archival device, for allowing output of the converted transcribed message to the archival device for output or storage thereon.

Damilba teaches a speech-to-text system that is portable (plug-and-play capabilities, paragraph 18) and having a port to communicate with exterior devices (3rd party service adapter, paragraph 86).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Padmanabhan to make the system portable with a port as taught by Damilba for communication with the converting device and an archival

device, for allowing output of the converted transcribed message to the archival device for output or storage thereon because it would give more functionality hence making the system more flexible.

16. As per claim 26, Padmanabhan teaches the transcription device is an integral part of the storing device (elements of Fig. 1 can be implemented by one computer, the elements of Fig. 1 include both the speech recognition server and telephony server, col. 3, lines 15-18).

17. As per claim 27, Padmanabhan teaches the archival device is an email (send text via email, col. 4, lines 62-67).

18. As per claim 28, Padmanabhan does not teach the archival device to be a printer.

However, the Examiner takes Official Notice that printers are a well known output device in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the system of Padmanabhan to have the archival device be a printer because it would give a hard copy transcription of the voice message hence facilitating use for the user.

19. As per claim 29, Padmanabhan teaches the archival device is a facsimile machine (send the text via fax, col. 4, lines 62-67).

Conclusion


20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lewis et al. (U.S. Pat. 6,775,651) and Field et al. (U.S. Pat. 6,651,042) teach transcribing voicemail to email.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Sked whose telephone number is (703) 305-8663. The examiner can normally be reached on Mon-Fri (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talivaldis Smits can be reached on (703) 306-3011. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MS
11/30/04


DAVID L. OMETZ
PRIMARY EXAMINER